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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,701	02/08/2002	David Z. Lubowski	5804.02	2673

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EXAMINER

LEUBECKER, JOHN P

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/071,701	Applicant(s) LUBOWSKI, DAVID Z.	
	Examiner John P. Leubecker	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-10 and 12-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-10 and 12-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 2-10 and 12-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 41, the only independent claim, now recites both a “coupling means” and a “light head”. The “coupling means” is only described with respect to drawing reference numerals 15 (e.g., Figure 2) and 44 (Figure 15). The “light head” is assumed to be referring to the “fibre optic head 5”, which is only shown in Figure 1 and described as being a prior art element. BOTH elements are described as allowing attachment of a light source (shown as numeral 8 in both Figures 1 and 2). In addition, page 7, lines 16-17 of Applicant’s specification states “Fibre optic head 5 constitutes coupling means for optically coupling a light source 8 with the speculum”, which portrays to the reasonable person that coupling means (15) of Applicant’s invention is analogous to the corresponding element (fibre optic head 5) in the prior art. Nowhere does the specification mention or even suggest that the coupling means and light head are coupled, or can be coupled to form a single combination of elements, as now implied by claim 41 (claim 1 recites “coupling means...adapted to allow a reusable light head...to be

connected to the observation end”). Since both the disclosed coupling means and the light head allow for attachment of the light source, the combination of the coupling means and light head would allow for TWO light sources to be attached to the device, which is also not disclosed or suggested in the disclosure.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-10 and 12-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 41, the intended meaning and scope of the term “light head” is indefinite, particularly when in combination with the claimed “coupling means”.

As to claim 42, recitation that the “observation window forms at least part of the coupling means” is indefinite as to its intended meaning since it explicitly contradicts the specification (i.e., page 17, lines 17-18 states “Those embodiments differ from the prior art in that the window is not a part of the coupling means but is disposable”).

As to claim 2, it is not clear whether or not claim 2 requires the “contamination means” since is not positively set forth as being part of the combination. Perhaps Applicant intended the words –further comprising—after the “and” in line 2.

As to claim 3, as dependent on claim 2, the phrase “the insufflation means are reusable” is redundant. As dependent on claim 41, term “contamination prevention means” lacks antecedent basis.

As to claims 4-8, as dependent on claim 41, term “contamination prevention means” lacks antecedent basis.

Due to the numerous defects and the excess number of claims due to multiple dependencies, the Examiner has not listed all defects. Applicant is required to carefully review and correct all such defects.

Claim Rejections - 35 USC § 102 and 103

5. Due to the defects listed under 35 USC 112, first and second paragraph, with respect to claim 41 (the only independent claim), the prior art will not be applied until the scope of the claim can be clarified. However, a brief discussion of the Fiore reference will be given to aid Applicant in responding to this Office Action.

Specifically, the previously applied reference to Fiore discloses a lighting head (24) which would appear to anticipate either a coupling means or light head, as defined by Applicant’s specification, but does not appear to anticipated both. However, Applicant’s specification does not appear to anticipate the combination of both either.

It is noted though, for Applicant’s consideration, that taking the elements (18), (19), (32) and (33) of Fiore as the “fluid tight observation window” (note col.4, lines 8-12, col.5, lines 9-14 and col.6, lines 45-59), this window “extends across the observation end of the speculum” as now claimed. This structure is very similar to the embodiment shown in Applicant’s Figure 6.

Response to Arguments

6. Applicant's arguments filed March 28, 2006 have been fully considered but they are not persuasive.

Before prosecution continues on this case, clarification is required with respect to claim terminology. As pointed out by Applicant in the last paragraph on page 7 of the remarks filed March 28, 2006, Applicant states that “the fibre optic light head and the coupling means of the present invention are not necessarily the same”. The Examiner agrees with this. The coupling means constitutes the part of the present invention and the fibre optic light head constitutes prior art. The differences between these two elements can be seen with the differences between the prior art fibre optic light head (5) shown in Figure 1 and the coupling means (15) shown in Figure 2. Both attach adjacent the observation end of the speculum and have a means (7) for attaching a light source (8), yet the prior art light head includes additional elements, such as spigot (9). Although Applicant states in the remarks that “the fibre optic light head may include a coupling means, but is not necessarily itself (or solely) the coupling means”, this appears to be subject matter that is not disclosed in the specification. The specification fails to disclose the combination of a light head and coupling means. Applicant bases this last mentioned statement on a sentence from the specification that says that the light head includes “means 7 for the releasable attachment of a light source”. Nowhere in the specification is the “means for the releasable attachment of a light source equated with the “coupling means”, which is explicitly used to reference element (15) (Fig.2).

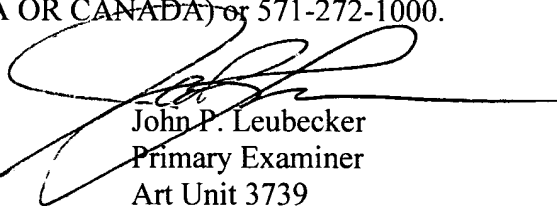
To avoid confusion in interpreting the claims, Applicant is requested to use terminology in the claims that is directly and explicitly supported by the specification.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


John P. Leubecker
Primary Examiner
Art Unit 3739

jpl